



SEP 25 2001

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In re Application of  
GRUHLKE et al.  
Application No.: 09/554,781  
PCT No.: PCT/EP98/07619  
Int. Filing Date: 28 November 1998  
Priority Date: 27 November 1997  
Attorney's Docket No.: METAL 1278-W  
For: SLAG CRUSHER

DECISION

This decision is in response to applicant's "CONTINUED PROSECUTION APPLICATION (CPA) REQUEST", filed 13 November 2000. The request is **REFUSED** for the following reasons.

**BACKGROUND**

On 18 May 2000, applicant requested entry into the U.S. national stage under 35 U.S.C. 371 for the above-noted international application and paid \$840.00 for the basic filing fee. The application was assigned U.S. serial number 09/554,791.

On 13 June 2000, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration executed by the inventors, an English translation of the international application, the \$130 surcharge for filing the oath or declaration and the \$130 processing fee for filing the translation after the thirty month period were required. Applicant was given one month to respond to the Notification of Missing Requirements. Extensions of time were available under the provisions of 37 CFR 1.136(a).

Thereafter, on 13 November 2000, applicant filed a response to the Notification of Missing Requirements providing a transmittal letter requesting a continued prosecution application (CPA) of 09/554,791 along with a request for a four month extension of time and the appropriate \$1,390.00 fee.

On 13 March 2001, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants indicating that the application was abandoned because applicant had failed to respond to the Notification of Missing Requirements within the time period set therein.

On 16 April 2001, applicant filed an executed declaration and an English translation of the international application along with the \$130 surcharge for filing the oath or declaration and the \$130 processing fee for filing the translation after the thirty month period.

### DISCUSSION

The application papers filed on 18 May 2000 clearly and unambiguously indicated that the application was being filed under 35 U.S.C. 371 as the national stage application of international application No. PCT/EP98/07619 by use of the "TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE... 35 U.S.C. 371" (Form PTO-1390) as the transmittal letter. Since applicant's transmittal letter did request treatment under 35 U.S.C. 371, included the basic national fee and no conflicting instructions were provided, the application was properly processed under 35 U.S.C. 371 and 37 CFR 1.494 rather than 35 U.S.C. 111 and 37 CFR 1.53.

The 13 November 2000 filing requesting treatment of the application as a continued prosecution application was an improper response to the 13 June 2000 Notification of Missing Requirements. Consequently the application went abandoned for failure to respond to the Notification of Missing Requirements.

Pursuant to 37 CFR 1.53(d)(1)(i)(C), a continuation application of a prior nonprovisional application may be filed as a continued prosecution application provided that the prior nonprovisional application is the national stage of an international application filed under 35 U.S.C. 365 before May 29, 2000 and is in compliance with 35 U.S.C. 371. In the instant case, applicant had not filed the English translation of the international application and the oath/declaration along with the appropriate fees for filing after the thirty month period to compliance with the requirements of 35 U.S.C. 371. Thus, it is not appropriate to treat the application as a continued prosecution application at this time.

### OPTIONS

To revive his abandoned application, applicant may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. See 62 Fed. Reg. 53131 (October 10, 1997); 1203 Off. Gaz. Pat. Office 63 (October 21, 1997) (Effective Date: 01 December 1997).

The filing of any petition under the unintentional standard cannot be intentionally delayed. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay was unintentional. A statement that the delay was unintentional is not appropriate if the petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137: (1) the delay in the reply that originally resulted in the abandonment; (2) the delay in filing an initial petition under 37 CFR 1.137 to revive the application; and (3) the delay in filing a grantable petition under 37 CFR 1.137 to revive the application. See Section 711.03(c) of the Manual of Patent Examining Procedure (MPEP).

This suggestion with regards to the option of filing a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

### CONCLUSION

The Request for Continued Prosecution Application is **REFUSED**.

The Notification of Abandonment mailed on 13 March 2001 remains in effect.

Any further correspondence with respect to this matter should be addressed to the

Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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